

fingers associated with each of the openings. As now amended, it is believed that the 112 rejection of the claims has been overcome.

Turning now to the 103 rejection of the claims, it should be noted that the independent claims have been rewritten to limit the invention to V-shaped resilient fingers associated with rectangular openings. As apparently recognized by the Examiner (note comment at page 7, last paragraph of the Office Action), the prior art does not disclose V-shaped resilient fingers and, as a result, it is respectfully submitted that the invention as now defined by these independent claims and the dependent claims is patentably distinguishable over the new combination of references relied upon by the Examiner.

More particularly, with respect to the rejection of Claims 18-20 as being unpatentable over Hartman in view of Dickey and Wang, as previously noted, Hartman simply discloses a cup holder for round cups while Dickey simply discloses a holder for rectangular beverage cups and Wang shows a heat insulated cup holder having a plurality of springy retaining members fastened to lugs inside the holder base for holding down a cup in the holder. It is only through hindsight reasoning in light of Applicant's disclosure, can these three references be combined in the manner suggested in the Office Action in an attempt to reconstruct the claimed invention which is, of course, improper.

While Hartman discloses a cup holder for round containers and Dickey specifically defines an ornamental design for a holder for rectangular beverages, it is unclear from their teachings how they could be combined in the manner suggested by the Examiner. Clearly, there is no suggestion in Hartman, et al. and Dickey for providing as presently claimed "at least two of said side walls disposed opposite one another each having at least two openings therethrough disposed beneath the top edge border thereof" and V-shaped "fingers each depending from one of said top edge borders of said opposite side walls such that they extend downwardly into a different one of said side wall openings. Indeed, even if Dickey was combined with Hartman, it would offer no suggestion of where the fingers were to be located and it certainly does not suggest providing the fingers in the two openings of two opposite side walls".

Indeed, it is unclear how the plurality of springy retaining elements of Wang would be added to this combination of references. No suggestion is provided by Wang or the other references. Would they be used to replace the fingers 16 of Hartman or would they be added to the ribs 22 of Hartman? In any event, the cited art does not suggest the provision of V-shaped resilient fingers extending from one of the top edge borders of the opposite side walls such that they extend downwardly into a different one of said side wall openings as set forth in Claim 18.

Moreover, as noted above, in order for the teachings of these patent references to be properly combined there must be some suggestion in the patents themselves which would suggest the desirability of such a combination.

The mere fact that prior art may be modified to produce the claimed invention does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 USPQ 2d 1780 (Fed. Cir. 1992). Such suggestion is clearly lacking here, necessarily causing the asserted combinations to fail in rendering the claimed invention obvious.

Similarly, with respect to the 103 rejection of the Claims 21-23 on the basis of Lorence in view of Dickey, Miller, Wang and Pratt, here too, none of the prior art references, either alone or in combination, suggest the provision of two sets of four resilient V-shaped fingers which depend from the top wall of the tray, each set of which is associated with a different rectangular opening as defined in Claim 21.

Finally, Applicant hereby requests a three-month extension of time in which to respond to the outstanding Office Action. A PTO-2038 form in the amount of \$460.00 is enclosed herewith for the official fee associated therewith. In the event of any deficiency for the required amount for an extension of time, please debit Deposit Account No. 07-0130.

In view of the foregoing, it is respectfully submitted that the claims as now amended are patentably distinguishable over the references of record, either applied, alone or in combination. Accordingly, reconsideration and withdrawal of the rejection and allowance of the claims at an early date is earnestly solicited.

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Enclosures: Version with markings to show changes to claims;  
PTO-2038 Form in the amount of \$460.00 for 3-month extension  
and postcard

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## **VERSION WITH MARKINGS TO SHOW CHANGES TO CLAIMS**

18. (Twice Amended) A beverage container holder for round and square beverage containers, comprising:

a rectangular basket having four side walls, each having a top edge border which collectively define an open top end and which, in turn, defines a rectangular opening, at least two of said side walls disposed opposite one another each having at least two openings therethrough disposed beneath said top edge border thereof; and

at least four resilient fingers coupled to said rectangular basket and extending inwardly toward said rectangular opening, said at least four resilient fingers being [generally] V-shaped to define a point of a V and having a V-shaped profile when viewed in a vertical plane with the point of the V extending generally towards the center of the rectangular opening, said at least four fingers cooperating to resiliently and releasably grasp both round and square beverage containers, said fingers each depending from one of said top edge borders of said opposite side walls such that they each extend downwardly into a different one of said [sidewall] side wall openings; and

a generally U-shaped hook attached to and extending above said basket.

21. (Twice Amended) A beverage container holder for round and square beverage containers, comprising:

a rectangular tray having a top wall having a pair of spaced-apart rectangular openings [four side walls, each having a top edge border which collectively define an open top end and which, in turn, defines a rectangular opening, at least two of said side walls disposed opposite one another having at least two openings therethrough disposed beneath said top edge border thereof]; and

at least two sets of four resilient fingers coupled to said rectangular [basket] tray and said fingers of each set extending inwardly toward a different one of said rectangular [opening] openings, said [at least four] resilient fingers being [generally] V-shaped to define a point of a V and having a V-shaped profile when viewed in a vertical plane with the point of the V extending generally towards the center of the respective rectangular opening, said at least four fingers of each set cooperating to resiliently and releasably grasp both round and square beverage containers, said fingers each depending from said top wall of said tray [one of said top edge borders of said opposite side walls such that they each extend downwardly into a different one of said sidewall openings]; and

a supporting member rotatably coupled to said rectangular tray and being pivotable into a position located below said rectangular opening.